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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/792,056	03/03/2004	Michael J. Otto	154-28553-US	4804
23770 PAULA D. MC	7590 12/29/200 DRRIS	EXAMINER		
MORRIS & AMATONG, P.C. 10260 WESTHEIMER, SUITE 360 HOUSTON, TX 77042-3110			MCAVOY, ELLEN M	
			ART UNIT	PAPER NUMBER
,			1764	
	-			
SHORTENED STATUTOR	Y PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE	
3 MO	NTHS	12/29/2006	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)					
Office Author O	10/792,056	OTTO ET AL.					
Office Action Summary	Examiner	Art Unit					
	Ellen M. McAvoy	1764					
The MAILING DATE of this communication app Period for Reply	ears on the cover sheet with the c	orrespondence address					
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING DA - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory period w - Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 16(a). In no event, however, may a reply be time 11 apply and will expire SIX (6) MONTHS from cause the application to become ABANDONEI	l. lely filed the mailing date of this communication. D (35 U.S.C. § 133).					
Status							
1) Responsive to communication(s) filed on							
	-· action is non-final.						
<u> </u>							
closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.							
Disposition of Claims							
4)⊠ Claim(s) <u>1-122</u> is/are pending in the application.							
4a) Of the above claim(s) is/are withdrawn from consideration.							
5) Claim(s) is/are allowed.							
6)⊠ Claim(s) <u>1-122</u> is/are rejected.							
7) Claim(s) is/are objected to.	•						
8) Claim(s) are subject to restriction and/or	election requirement.						
Application Papers							
9) ☐ The specification is objected to by the Examiner	۲.						
10)⊠ The drawing(s) filed on <u>03 March 2004</u> is/are: a)⊠ accepted or b)⊡ objected to by the Examiner.							
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).							
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).							
11) The oath or declaration is objected to by the Ex	aminer. Note the attached Office	Action or form PTO-152.					
Priority under 35 U.S.C. § 119							
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of:							
1. Certified copies of the priority documents		on No					
2. Certified copies of the priority documents3. Copies of the certified copies of the prior	· ·						
application from the International Bureau	·	a in this National Stage					
* See the attached detailed Office action for a list of	, , , ,	d.					
	,						
Attachment(s) 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413)							
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) Paper No(s)/Mail Date.							
3) Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date 9/15/2004; 8/25/2005. 5) Notice of Informal Patent Application 6) Other:							
Paper No(s)/Mail Date 9/15/2004; 8/25/2005. 6) Utiler:							

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-9, 13-24, 33-35, 37-41, 47-52, 58-60, 63-67, 69-74, 79-81, 83-88, 97-103 and 111-113 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukutani (6,448,207).

Fukutani et al ["Fukutani"] discloses an aqueous metal working fluid containing water and as additives, a metal stearate including lithium stearate, a carbonate, a hydrogencarbonate, and a surfactant. See column 2, lines 18-46. The metal working fluid may further contain ethylene glycol and a rust inhibitor. The examiner is of the position that Fukutani meets the limitations of independent claims 1, 33, 47, 58, 63, 79, 97 and 111 which "comprises" at least one alkali metal fatty acid soap dispersed in a carrier fluid. The examiner is of the position that the term "carrier fluid" is broad enough to include both water and ethylene glycol. Although the prior art does not teach drilling fluids, the preamble language "lubricants for drilling fluid systems" is a statement of intended use which carries no weight in the composition claims. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able

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to stand alone. See In re Hirao, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claim Rejections - 35 USC § 103

Claims 1-15, 19-32, 63-69 and 121 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mondshine et al (3,761,410).

Mondshine et al ["Mondshine"] disclose water based drilling fluids having enhanced lubricating properties by the addition thereto of a lubricating additive, such as animal fats, vegetable oils and fatty acids, and mixtures thereof; and a water-insoluble alcohol component having 4-15 carbon atoms. Suitable vegetable oils include castor oil, soybean oils, cottonseed oils, sunflower oils and corn oils. See column 5, lines 1-10. Suitable alcohols include any water insoluble alcohol having 4-15 carbon atoms butanol, hexanol, and dodecanol. See column 5, lines 49-54. A pour point depressant may also be added to the water based drilling fluids including ethylene glycol, propylene glycol, and mixtures therof. Mondshine teaches that the water component of the water based drilling fluids include fresh water, salt water, and sea water. See column 6, lines 50-64. The examiner is of the position that Mondshine meets the limitations of the drilling fluid of the claims since the combination of salt water/sea water and vegetable oil will result in sodium salts of the vegetable oils.

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Claim Rejections - 35 USC § 103

Claims 1-122 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark et al (5,658,860) alone or incombination with Chesser et al (6,403,537).

Clark et al ["Clark"] disclose a well fluid emulsion having a water phase and an oil phase of a sulfurized alcohol and a naturally occurring fat, oil or derivatives thereof. Also disclosed is a method of lubricating drilling equipment used in conjunction with the drilling. Suitable naturally occurring fats and oils may be obtained from vegetable oils such as castor oil, coconut oil, corn oil, cottonseed oil, olive oil and sunflower oil. The preferred class of alcohols are glycols and polyglycols having a molecular weight in the range of about 200 to about 2000. See column 3, line 39 to column 4, line 21. Suitable fatty acids include include those having a carbon chain length of 8-30 carbon atoms. Clark teaches that derivatives of the fatty acids may be used including alkali metal derivatives. See column 5, lines 37-58. The examiner is of the position that the drilling fluid of Clark clearly meets the limitations of most of the above rejected claims. Applicants invention differs in some depending claims by adding one or more monomers comprising acrylamide. However, Chesser et al ["Chesser"] is added to teach that drilling fluid systems conventionally contain acrylamide monomers. Having the prior art references before the inventors at the time the invention was made it would have been obvious to have added the acrylamide monomers of Chesser to the drilling fluids of Clark if the known imparted properties were so desired. It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, here as drilling fluids, in order to form a third composition to be used for the

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very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." <u>In re Kerkhoven</u>, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M. McAvoy whose telephone number is (571) 272-1451. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO

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Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Primary Examiner Art Unit 1764

EMcAvoy December 22, 2006